

REMARKS/ARGUMENTS

Applicants have reviewed and considered the Final Office Action mailed on January 11, 2006.

No claims were amended, cancelled or added. Claims 1-27 are pending in this application.

Applicants respectfully note that claims 26 and 27 were presented as new claims in Applicants' October 21, 2005 response to the August 10, 2005 Office Action. The Office Action summary sheet and Final Office Action itself, however, do not indicate that claims 26 and 27 are either pending or rejected. In addition, claim 22 was indicated to be rejected on the Office Action summary sheet, but Applicant was not able to find the detailed basis for the claims rejection in the Office Action. Applicants respectfully request an indication that claims 26 and 27 have been entered in the next official communication. In addition, Applicants respectfully request the basis for the rejection of claims 22, 26 and 27, if any, in the next official communication.

§103 Rejection of the Claims

Claims 1, 2, 9, 12, 13, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827).

Claims 3 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of Killey.

Claims 4, 6-8, 10, 11, 14-16 and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of McConville et al.

Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1, 2, 9, 12, 13, 23 and 24 above, and further in view of Killey and McConville et al.

Applicants respectfully traverse the rejections as follows.

Claims 1, 2

The Examiner has essentially repeated the rejection of claims 1 and 2 as presented in the Office Action dated August 10, 2005. In response, Applicants respectfully repeat their October

21, 2005 discussion as to why Stephens and Smith do not support a proper prima facie case of obviousness. Applicants address the Examiner's response to these arguments below.

As previously presented, the cited documents do not teach or suggest all of the elements recited in claims 1, 2. For example, the cited documents do not teach or suggest a transparent data sheet having a transparent durable layer and a transparent fragile layer, as recited in claim 1. In contrast, Stephens provides a "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material . . ." (Col. 3, lines 7-12). Stephens does not teach or suggest that these materials are structurally different. Rather Stephens provides that the plies 12' and 12" are made of the identical transparent thermoplastic material. So, it is not possible for Stephens' to teach or suggest that the plies 12' and 12" are some how both "durable" and "fragile" as asserted by the Examiner. As such, Stephens does not teach or suggest all the elements recited in claim 1.

As for claim 2, Stephens does not teach or suggest a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, wherein the laminate is durable. Rather, Stephens provides an "envelope 12" having "plies 12', 12"" of a transparent thermoplastic material, but does not teach or suggest that theses plies are fragile layers that when laminated become durable, as provided in claim 2.

As the Examiner appreciates, during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

Applicants clearly recite the features upon which they rely in the claims. In addition, Applicants clearly define and distinguish the recited terms "durable" and "fragile" in the specification, where "[t]he term 'fragile' as used in this application means a film or material that

is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26), and "[a]s used in the application 'durable' means a film that is free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling" (page 2, lines 26-29). These definitions provided by the Applicants are even consistent with secondary source definitions of "fragile" (1. Easily broken, damaged, or destroyed; frail. 2. Lacking physical . . . strength; delicate. 3. Lacking substance; tenuous or flimsy" The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 720) and "durable" (1. Capable of withstanding wear and tear or decay . . . 2. Lasting; stable" The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 572).

In responding to the Applicants' argument, the Examiner asserts that "it is noted that the features upon which applicant relies (i.e., the specifics of the 'durable' and 'fragile' layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181 26 USPQ2d 1057 (Fed Cir. 1993)."

As discussed above, Applicants expressly recite the terms "fragile" and "durable" in the claims, where these terms are clearly and expressly defined in the specification. This is in contrast to the facts in *In re Van Geuns* cited by the Examiner, in which Van Geuns tried to limit the phrase "uniform magnetic field" of a magnetic assembly recited in the claim to that of an NMR or MRI apparatus among others generally provided in the specification. In other words, Van Geuns tried to limit the phrase recited in the claim by narrowly reading its meaning from a broader recitation in the specification. As such, *In re Van Geuns* is distinguished from the present case, as Applicants' are not trying to limit the interpretation the terms "fragile" and "durable," as was the case in *In re Van Geuns*.

In addition, Applicants respectfully submit that even if the Examiner maintains the assertion that the express definitions provided in the specification for "fragile layer" and "durable layer" cannot be read into the claim language, the plain meaning of the words "fragile" and "durable" (see above dictionary definitions for these words) for the layers recited in claim 1 distinguishes the claim over Stephens. This is because Stephens only teaches or suggests two plies (12' and 12") from the same material (i.e., the "plastic envelope 12"), rendering it

impossible for Stephens to teach that a single material can provide in the same instance one layer that is "fragile" and one layer that is "durable."

The Examiner further asserts that "applicant has not disclosed any criticality to the use of a 'fragile' or 'durable' layer in his assembly." Applicants respectfully submit that they are unable to find a rule, law or discussion in the MPEP that disclosing the "criticality" of a claim element is a requirement of patentability. The MPEP does, however, discuss the situation where a claim that omits an element that applicant describes as an essential or critical feature of the invention would not comply with the written description requirement (see for example, MPEP 2163 I.B. and 2164.08(c)). The instant application, however, has not used the *per se* words "critical" or "essential" to describe an element in the specification. As such, Applicants are unaware of what rule or law, either substantive or procedural, the Examiner is submitting has not been met by the Applicants.

The Examiner then asserted that "[f]urther there is no recitation defining the function of the 'fragile' or 'durable' layer" (Final Office Action, page 5). It would appear that the Examiner is asserting that the present disclosure is lacking these recitations. Applicants respectfully traverse this assertion and submit that any number of recitations as to the function of the "fragile" and "durable" layer can be found through out the specification. For example, page 2, lines 24-26 provide that:

The term "fragile" as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing.

So, at least one "function" of the fragile layer, among others, is to be mechanically weak. In addition, page 2, lines 26-30 provide that:

As used in the application the term "durable" means a film that is free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling, such as typical passport use.

So, at least one "function" of the durable layer, among others, is to be a free-standing film without the need for a carrier layer, and to be thermally stable to withstand laminating or other processing temperatures.

Applicants further provide that:

Advantageously, the present invention provides a transparent data sheet that contains one or more security features, including but not limited to the destruction of the fragile layer indicating tampering or attempted delamination.
(page 3, lines 26-28)

So, an additional "function" of the fragile layer, among others, includes the ability to indicate tampering or attempted delamination of the transparent data sheet of the present disclosure.

In addition, the Examiner asserts that "[t]here is no recitation explaining its use in fraud detection or tampering" (Final Office Action, page 5). With respect to the instant patent application, Applicants respectfully submit that the words "fraud detection" are not recited in the pending claims. Applicants do, however, recite the word "tampering" in claim 19 to provide that the transparent data sheet further includes "a layer of hot melt adhesive that can not be re-used without evidence of tampering" (pending claim 19). Based on the plain language of the claim, the word "tampering" is used in conjunction with a layer of hot melt adhesive that can not be reused (e.g., the hot melt adhesive having been sealed is separated then rejoined) without evidence of tampering with the hot melt adhesive.

The Examiner also states that while "Stephens discloses two layers made of a thermoplastic material. It does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative durability." (Final Office Action, page 4). It appears that the Examiner is relying, at least in part, upon an inherency argument in rejecting the present claims. Applicants respectfully traverse.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (M.P.E.P. 2112, *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). "To establish inherency, the extrinsic evidence 'must

make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

First, Applicants respectfully submit that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. Second, the Examiner has provided no extrinsic evidence that would suggest, be recognized by, or made clear to one skilled in the art that the missing descriptive matter (e.g., the "different sections [that could] consist of different polymers to inherently provide layers of different/relative durability") is necessarily present in the "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material. Finally, it would appear that the Examiner's assertions (e.g., "[i]t does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative durability") rely upon probabilities and/or possibilities, which are insufficient to support a proper inherency argument.

Based on the forgoing, Applicants respectfully submit that a proper rejection based on inherency has not been made.

With respect to Applicants' argument that there is no suggestion or motivation to combine the documents, the Examiner responded by asserting that "[i]n this case, all of the cited references are clearly in the field of endeavor of applicant's claimed invention." This assertion, however, does not address what explicit or implicit problem Stephens motivates one skilled in the art to solve, nor does it address what motivation is taught or suggested for one skilled in the art to print additional information on either of the plies 12' or 12" of Stephens (as discussed in Applicants' May 24, 2005 response).

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claims 1 and 2 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

Claims 23 and 24

The Examiner has essentially repeated the rejection of claims 23 and 24 as presented in the Office Action dated August 10, 2005. In response, Applicants respectfully repeat their October 21, 2005 discussion as to why Stephens does not support a proper conclusion of inherently teaching the methods of claims 23 and 24, and why Stephens and Smith do not support a proper prima facie case of obviousness.

Based on the forgoing, Applicants respectfully submit that each and every element as recited in independent claims 23 and 24 are not taught or suggested in the cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

Reconsideration and withdrawal of the § 103 rejection for the above independent claims, as well as those claims which depend therefrom, are respectfully requested.

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration and allowance of the pending claims is respectfully requested.

The Examiner is invited to telephone the applicants' below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

Date

3/13/2006

By:

Joseph C. Huebsch
Joseph C. Huebsch, Reg. No.: 42,673
Telephone No.: (612) 236-0122